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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,456	06/13/2001	Melanie Brunner	48662/DIV	6527

26474 7590 06/18/2002

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1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

FOROHAR, FARHAD

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/18/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/879,456

Applicant(s)

BRUNNER ET AL.

Examiner

farhad

forohar

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

R sponds to Remarks

The response filed on 03/18/2002 has been entered. In view of the IDS supplied by the applicant the 35 USC 112 second paragraph rejections have been withdrawn. Applicant's arguments have been fully considered but they were not deemed to be persuasive. Therefore, claims 12-15 remain rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al (JP 07-173342 or 07-011074 or 06-306252).

Claim Rejections - 35 USC § 102

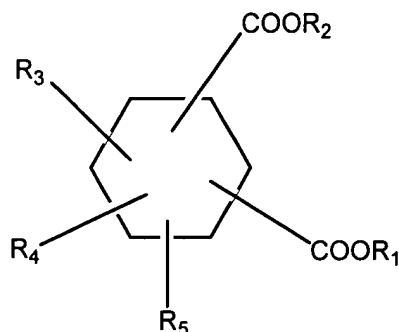
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-15 remain rejected under 35 U.S.C. 102(b) as being anticipated by Sakurai et al (JP 07-173342 or 07-011074 or 06-306252).

The present invention recites a group of compounds of 1,2-dialkyl cyclohexanedicarboxylic acid esters with the dialkyl groups being defined in claims 12 and 13. Sakurai et al teach a cyclohexane structure as shown below (Note: in the office action of 12/12/2001 the structure was incorrectly presented with two hydrogen atoms):



Where, R₃₋₅ are hydrogen or other defined substituents, and R¹ and R² are 6-28C alkyl or alkenyl. Some examples of these compounds are diisononyl hexahydrophthalate, and didecyl hexahydrophthalate (STN abstract of JP 07-173342). These compounds are used for compositions having excellent low-temperature impact resistance, flexibility, and moldability.

Compounds are defined by their atoms and bonds and are not distinguished by the manner with which they are made.

Response to Applicant's Arguments

In the response of 03/18/2002 the applicant argues, "the instant claims are drawn to very specific mixtures of esters of cyclohexane-1,2-dicarboxylic acid". The examiner would like to point out that the way the claims are written they are drawn to **compounds**. The method by which the compound is made (i.e. the hydrogenation method) is not the issue in this application, because it is not the process but the compound that has been claimed.

The applicant further argues that no single ester is identified in the abstracts supplied by the examiner. This is incorrect because the STN abstract of '342 specifically names

diisononyl hexahydrophthalate which is an ester. Furthermore, the applicant argues that in '342 where diisononyl hexahydrophthalate and didecylhexahydrophthalate are specifically disclosed these esters "are not among the ones recited in claims 12 or 13". The applicant errs by not noticing that diisononyl hexahydrophthalate mentioned in '342 is actually the "cyclohexane-1,2-dicarboxylic acid di(isononyl) ester" recited in line 9 of new claim 12. In fact the process to synthesize diisononyl hexahydrophthalate is explained in page 24 (Example 2) of the specification, where diisononyl hexahydrophthalate is produced in 99.5% yield. For the reasons of above the 35 USC 102 rejection of the first office action is maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 1623

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhad Forohar. The examiner can normally be reached on Monday-Friday between the hours of 8:00 a.m. and 5:00 p.m. at (703) 305-1022.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter, SPE of Art Unit 1623, may be reached at (703) 308-4532. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4556.

For 24 hour access to patent application information 7 days a week, or for filing applications electronically, please visit our website at www.uspto.gov and click on the button "Patent Electronic Business Center" for more information.

F.F.
June 14, 2002


(for) Johann R. Richter, Ph.D., Esq
Supervisory Patent Examiner

6/17/02

TC 1600